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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,893	05/25/2001	Gerald Storch	10505-236866	8027

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EXAMINER

KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,893

Applicant(s)

STORCH ET AL.

Examiner

James A. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5, 11 - 24 is rejected under 35 U.S.C. 102(e) as being anticipated by Tobin.

Tobin teaches a system for co-branding a web site between two partner companies. (e.g. reference column 9; lines 5-50). Specifically this is used for Internet shopping, but Tobin teaches the system applicable to Intranets defined by a particular class of online customer such as Digital City customers which are a part of America Online's service (column 16; lines 62-66).

Examiner references Tobin's example of an Internet site providing floral and gift services; PC Flowers and Gifts. Specifically, Tobin teaches Internet Service Providers display PC Flowers and Gifts Web site pages customized to the requirements of the participating ISP (column 5; lines 4-18).

Tobin further teaches an order page which allows for customizations. Specifically, the customizations manifests in pricing incentives, discounts by percentage or fixed dollar amount.

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Examiner notes this clearly teaches providing members/shoppers with incentives to access and shop on the co-branded Internet site.

Examiner references Figures 11A-11C, which illustrates co-branded web site of PC Flowers and Gifts and their marketing partner Pathfinder. Examiner notes that in this example Pathfinder represents the ISP and PC Flowers and Gifts the Internet shopping site. Examiner further notes that Figures 11A-11C teach 1) providing a link to the Internet shopping site (PC Flowers and Gifts) on all pages of the Internet service site(Pathfinder); 2) providing a link to the Internet shopping site (PC Flowers and Gifts) with icon comprising one or more trademark logos of the retailer (PC Flowers and Gifts); 3) providing a tool bar with links to the Internet shopping site (PC Flowers and Gifts).

Examiner notes that claims 11 and 12 require the distribution of the co-branded site from the Internet Shopping site and the ISP respectively. Tobin teaches this distribution as co-branded site is developed (or distributed) based on a request/hypertext link from either the Internet Shopping site (PC Flowers and Gifts) or the ISP (Pathfinder).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of Official Notice.

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Claims 6-9 detail incentives offered by either the retailer (PC Flowers and Gifts) or the ISP (Pathfinder) to the member/shopper for using the co-branded system.

Claims 6 and 7, specifically require providing members/shoppers with advance notice of events.

Claims 8 and 9, specifically require providing the member/shopper with discount on subscription fees for the ISP.

Tobin, as described in detail above does not specifically teach either of these forms of incentives. Examiner takes Official Notice that both of these forms of incentives are old and well known in the art in order to entice members/shoppers to purchase items from a site.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the co-branded Internet shopping site of Tobin to include an incentive package that provides member with either advance notice of events sponsored by the retailer (PC Flowers and Gifts) or discounts on subscription fees to the ISP (Pathfinder) in order to entice customers to shop on the co-branded site.

Claims 10-12 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of Official Notice.

Claims 10 and 25-26 require the distribution of software via a retail store. Examiner takes Official Notice that it is old and well known in the art for ISPs to distribute their software via retail stores. For example AOL gives away versions of their software at WalMart, Best Buy, Radio Shack, etc in order to reach customers that do not have Internet access.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the ISP of Tobin so that their software was distributed at a retail

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chain, as taught by Official Notice in order to reach customers that do not currently have Internet access.

Conclusion

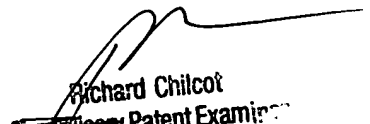
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer
Examiner
Art Unit 3627

JAK


Richard Chilcot
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